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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,836	04/17/2004	Wade C. Horton	HORTON-PA-1	8772
7590 06/10/2009				
OBER / KALER c/o Royal W. Craig 120 East Baltimore Street Baltimore, MD 21202				
EXAMINER				
FIGUEROA, ADRIANA				
ART UNIT		PAPER NUMBER		
3633				
MAIL DATE		DELIVERY MODE		
06/10/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/825,836

**Applicant(s)**

HORTON, WADE C.

**Examiner**

Adriana Figueroa

**Art Unit**

3633

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 6, 9-11, 13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 9-11, 13 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4/17/2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the limitation in claim 1, "the thin rigid sheet of material having an annular lip protruding rearwardly there from for insertion into, seating within and proper positioning with said cutout" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-4, 6, 9, 10, 13, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bobrick (US 3,697,742) in view of Hill (US 4,800,239).

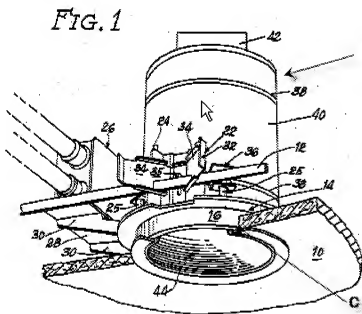
Regarding claim 1, as best understood, Bobrick discloses in combination with a ceiling (10) comprising a planar surface defined by opposing sides and having a circular cutout (c) there through, a recessed lighting fixture (I) mounted on one side of said planar surface over said cutout and conforming thereto, (annotated Fig 1), and a finishing ring (46) defined by an aperture conforming to said cutout, said finishing ring being mounted on another side of said planar surface around said cutout and attached to the recessed lighting fixture (I) for providing a transition from said planar surface to said recessed lighting fixture, (Fig 1, Fig 5), but does not disclose an accent frame comprising a rigid thin sheet of material said rigid thin sheet having an outer edge defining a flat two-dimensional object-shape larger in diameter than a finishing ring, and a convex inner edge defining an circular aperture conforming to said cutout, and having an annular lip circumscribing said aperture and protruding rearwardly there from for insertion into, seating within, and proper positioning with said cutout, said accent frame being sandwiched between said finishing ring and planar surface and maintained in

place there between by the pressure of said finishing ring being retained to said recessed lighting fixture; the flat two-dimensional object-shaped outer edge of said accent frame protruding beyond said finishing ring and serves as an aesthetically pleasing backdrop to said finishing ring, serving to cover up any imperfections in the finish or cut of the surrounding planar surface.

However, Hill teaches an accent frame(10) comprising a rigid thin sheet of material said rigid thin sheet having an outer edge (e) defining a flat two-dimensional object-shape larger in diameter than a finishing ring (5), and a convex inner edge (c) defining an aperture conforming to a cutout, and having an annular lip (l) circumscribing said aperture; said accent frame (10) being sandwiched between said finishing ring (5) and a planar surface and maintained in place there between by the pressure of said finishing ring being retained to the switch plate, (Fig 4); the flat two-dimensional object-shaped outer edge (e) of said accent frame (10) protruding beyond said finishing ring (5) and serves as an aesthetically pleasing backdrop to said finishing ring, serving to cover up any imperfections in the finish or cut of the surrounding planar surface, (Fig 1, 2, 4). Examiner would like to point out that the convex inner edge of Hill is considered to have the same structure of the convex inner edge of the instant application. Therefore, it would have been obvious to a person having ordinary skill in the arts at the time of the applicant's invention to modify the lighting fixture assembly of Bobrick to include an accent frame as taught by Hill in order to provide an ornamental appearance and to enhance the general appearance of the lighting fixture assembly.

The annular protruding lip of Hill does not protrude rearwardly there from for insertion, seating within, and proper positioning with said cutout. However Bobrick teaches that it is well known in the art to have a protruding lip (48) that would allow for easier insertion of the element (46) into the cutout (Fig 2, 5). Therefore, it would have been obvious to a person having ordinary skill in the arts at the time of the applicant's invention to modify the rigid thin sheet of material of Hill to include a protruding lip as taught by Bobrick in order to allow for easier insertion of the element into the cutout.

It would have been an obvious matter of design choice to modify the rigid thin sheet of material to have the convex inner edge defining a circular aperture, since such a modification would have involved a mere change in the shape of the component and would provide accent frames that can be used in a circular cutout. A change in shape is generally recognized as being within the level of ordinary skill in the art.



Regarding claim 2, Bobrick modified by Hill discloses as discussed above. Hill further teaches the accent frame (10) having a decorative outer edge (e), (annotated Fig 1, 2).

Regarding claim 3, Bobrick modified by Hill discloses as discussed above. Hill further teaches the accent frame (10) being seated flush with said planar surface (p), (annotated Fig 4).

Regarding claim 4, Bobrick modified by Hill discloses as discussed above. Hill further teaches the accent frame (10) flares slightly away from the planar surface (p) to provide an aesthetically pleasing depth or texture to the frame, (annotated Fig 4).

Regarding claim 6, Bobrick modified by Hill discloses as discussed above, but does not specifically teaches said thin sheet of material is approximately 1 mm thick. However, it would have been a matter of design choice to make the thin sheet approximately 1 mm thick, since such a modification would have involved a mere change in the size of the component and would provide a light weight sheet. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955).

Regarding claim 9, Bobrick modified by Hill discloses as discussed in claim 1 Bobrick further teaches the planar surface being a ceiling (10), (Fig 1).

Regarding claim 10, Bobrick modified by Hill discloses as discussed in claim 1, but does not disclose said frame is constructed of a rigid material selected from the group consisting of wood, metal or plastic materials. However, it would have been a matter of design choice to construct the frame of wood, metal or plastic materials since

it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Regarding claim 13, Bobrick modified by Hill discloses as discussed above. Hill further teaches the accent frame (10) is both decorative and is capable of covering up any imperfections in the edges of the cutout not covered by the finishing ring.

Regarding claim 14, Bobrick modified by Hill discloses as discussed in claim 1, but does not disclose the object-shape is a closed form selected from the group consisting of a star, flower or a house. However, it would have been an obvious matter of design choice to modify the object of Bobrick and Hill to have a shape of a star, flower or a house, since such a modification would have involved a mere change in the shape of the component and would provide different decorative motives. A change in shape is generally recognized as being within the level of ordinary skill in the art. *In re Dailey*, 357 In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).



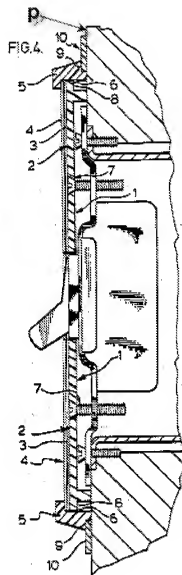
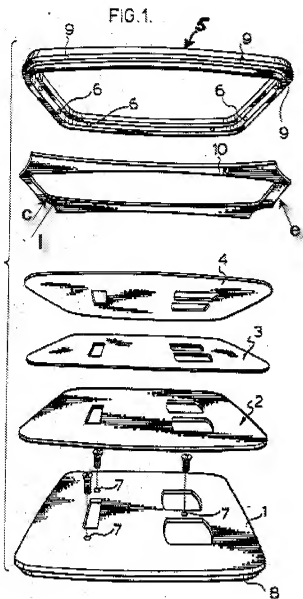
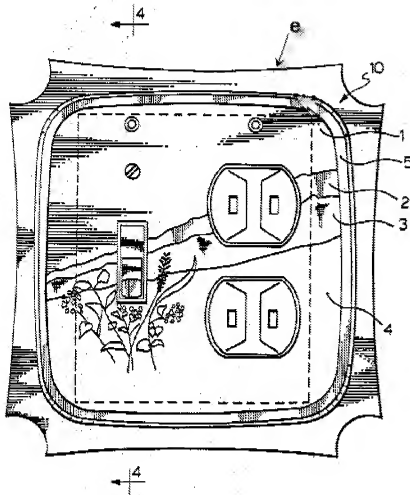


FIG. 2.



3. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bobrick (US 3,697,742) in view of Hill (US 4,800,239) and further in view of Gretz (US 6,152,413). Bobrick modified by Hill discloses as discussed in claim 1, but does not disclose said frame is formed by injection molding. However, Gretz discloses a frame (10) formed by injection molding (Column 4, Lines 56-60). Therefore, it would have been obvious to a person having ordinary skill in the arts at the time of the applicant's

invention to modify the frame of Bobrick and Hill to be formed by injection molding as taught by Gretz in order to provide a stronger and flexible frame.

### ***Response to Arguments***

4. Applicant's arguments filed 02/25/2009 have been fully considered but they are not persuasive.

In response to Applicant's argument that Hill does not show a convex inner edge, Examiner asserts that the accent frame of Hill shows a convex inner edge (c) that have the same structure of the convex inner edge of the instant application. Examiner would like to point out that the inner edge of Hill can specifically be seen convex on the inner corners of the rigid sheet of material. In addition, Applicant is claiming a flat two dimensional object and the rigid thin sheet of material of Hill meets this limitation.

### ***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adriana Figueroa whose telephone number is 571-272-8281. The examiner can normally be reached on Monday-Friday 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on 571-272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. F./  
Examiner, Art Unit 3633  
06/08/2009

/Brian E. Glessner/

Application/Control Number: 10/825,836

Page 12

Art Unit: 3633

Primary Examiner, Art Unit 3633